amendments to the claims were entered. If Applicant disagrees with the renumbering, it should be brought to the attention of the Examiner, along with proper numbering claims.

Misnumbered claims 10-28 have been renumbered as 9-27.

Applicant accepts the Examiner's renumbering; this renumbering is reflected in this amendment.

Claim Rejections

In the Office Action, the Examiner rejected the claims as follows:

Rejection under 35 U.S.C § 102

5. Claims 3, 4, 7, 9, 10-12 and 23, 24, 26 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by **Ahuja** et al., US Patent 5,689,533.

As to claims 3, 4, 7, 23, 24 and 27, Ahuja discloses a teleconferencing system for conducting a teleconference among a plurality of participants (See Col. 1, lines 11-24), comprising:

a workstation associated with each of at least three participants, each workstation having at least one origination and at least one reproduction capability, each selected from the group consisting of audio, video, and data origination/reproduction capabilities (Fig. 1, #s 18, 30, 36, 46, 60 and 68, Col. 4, lines 7-14);

a first network providing a data path for carrying digital data signals among the workstations (Fig. 1, #10);

a data conference manager for managing a real-time data conference during which shared data is displayed on the workstation monitors of a plurality of the participants (Fig. 2, #11, Fig. 5 and Col. 9, line 62-Col. 10, line 33);

an AV path for carrying AV signals, representing video images and spoken audio of the participants (Fig. 12, #s 190 and 216, 196 and 220, and Col. 2, lines 33-34;

a plurality of AV reproduction devices each having capabilities for reproducing audio or video signals at a workstation and configured to address a request for audio and/or video reproduction services generated at one of the workstations (See Fig. 1, the phone and the

monitors);

an AV conference manager for managing the real-time reproduction of the video images and audio of one participant at the workstation of another participant (Fig. 6 and 12, #230 "USER PROFILE"), wherein a service directory tracks the capabilities associated with each workstation, whereby a call, from a second to a first participant, and including a request for a service with respect to the first participant, is processed based on which capabilities are associated with the first participant, such as audio reproduction only or data only conferencing for the participant lacking other capabilities (Col. 2, lines 47-51, Col. 2, line 56-Col. 3, line 8 and Col. 14, lines 3-28).

As to claims 9 and 26, Ahuja further discloses a signal format converter configured to convert signals of one format to another format, whereby the teleconferencing system can support originating and reproduction devices based on different signal format standards (The hybrid bridges, Col. 6, line 60-Col. 7, line 2 and Col. 8, line 48-Col. 10, line 33).

As claims 10-12, Ahuja further discloses routing AV signals through a gateway to a remote network (Col. 5, line 59-Col 6, line 29 and Fig. 12, #186 and Col. 14, lines 37-42), gateways typically do not decompress data being routed (See also Fig. 12, #s 190 and 194 for compressing and decompressing of the AV data).

This rejection is overcome by the submission of the attached copy of a Rule 131 affidavit swearing behind this (and another) Ahuja patent. This Rule 131 affidavit was previously submitted in co-pending application 08/650,123, which has an identical specification and earliest and filing date as for this application.

THE EXAMINER'S ATTENTIONIS DRAWN TO THE FACT THAT THIS AFFIDAVIT IS ONLY APPLICABLE TO THE AHUJA REFERENCE(S) AS THEY APPLY TO CLAIMS 3 TO 27. IT DOES NOT APPLY TO THE NEWLY ADDED CLAIMS 28 ONWARD.

Newly added claims 28 onward all depend from independent claims 28 or 39. Both these independent claims include the "participant locator" functionality limitation found in claim 6. The Examiner has indicated that this functionality is obvious by reasoning as follows:

Claim Rejections – 35 USC § 103

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ahuja in view of **Burke** et. al., US Patent 4,451,705.

Ahuja teaches the invention substantially as claimed, and as explained above in rejection of claim 27.

Ahuja does not teach the participant locator.

Burke teaches a teleconferencing system in which a callee/participant is located by locating the workstation at which the participant is logged on, and routing the call to the workstation (See Abstract, Fig. 4, #508, also see claim 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the participant locator feature taught by Burke in the system taught by Ahuja in order to accommodate free movement of participants from a workstation to another workstation (See Burke, Col. 1, lines 23-30).

The Examiner also rejected other claims, finding approximate equivalents in the claims dependent on claims 28 or 39. However, as all newly added claims are dependent on claims 28 or 39, these dependent claims are believed patentable as well. Accordingly any rejections that may apply to these dependent claims are overcome by their dependency on an allowable base claim.

Both newly added independent claims contain, as indicated above, a "locator" function. Thus the claimed teleconferencing system operates to associate a participant

with each workstation at which the participant may log in and to route a videoconference call, for that participant, to each workstation at which that participant is logged in.

The Examiner's attention is drawn to application 08/664,238 in which this element is claimed in a different independent claim. In application 08/664,238, the PTO (Examiner Dinh) has cited Vin and Rangan as two references showing similar functionality. As is apparent from Applicants PTO correspondences in that application, this is not correct. The functionality in these claims differs fundamentally from the "call forwarding" and "visiting" functions disclosed in the Vin and Rangan references. In any event, as discussed, it is not possible to combine the multiple video server/ virtual conference room model of Ahuja with either the Vin or the Rangan architecture. Both Vin and Rangan are also of record in this application.

The Examiner relies on Burke in combination with Ahuja in his obviousness rejection of claim 6. It is submitted that such a combination is not obvious, nor feasible as will be discussed below.

For the Examiner to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - §

2143.03 for decisions pertinent to each of these criteria."[1]

Furthermore, "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.' *Ex parte Clapp* , 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)."[2]

First, the combination of references does not teach all the claim limitations. The burke system does not allow a call to be routed *to each workstation* (or telephone in Burke) as required by the claims. Indeed, such a configuration would lead to a very strange telephone based sytem and is neither apparent form nor suggested by Burke.

Second, and a very strong indication that Burke cannot be combined with Ahuja, is found in the fact that Burke is a single, small campus based system, while Ahuja is a multiple campus based system, the same environment the claimed invention operates in. This distinction was discussed with the Examiner and it is re-emphasized here that there is no teaching in Burk that would lead one to apply Burke's teaching to the multiple campus system of Ahuja. Indeed, it is submitted that such technology is not available in the standard telephone environment that Burke finds application.

Accordingly, the required "reasonable expectation of success" [3] for a combination of references cannot be obvious as alleged by the Examiner. Accordingly, Applicants submit these newly added claims are allowable.

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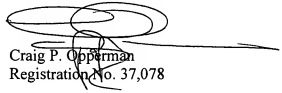
[1] MPEP § 706.02(j)
[2] MPEP § 706.02(j)
[3] MPEP § 706.02(j), p. 700-17.

CONCLUSION

For the reasons provided above, Applicants respectfully submit that this application is allowable. Should the Examiner believe that allowance can be expedited by a teleconference, he is invited to call the undersigned.

Respectfully submitted,



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